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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,909	10/13/2006	Estelle Bonnet	1759.236	6494
23405 7590 01/26/2009 HESLIN ROTHENBERG FARLEY & MESTI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203				
EXAMINER				
CHEN, CATHERYNE				
ART UNIT		PAPER NUMBER		
1655				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,909

Applicant(s)

BONNET ET AL.

Examiner

CATHERYNE CHEN

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Currently, Claims 1-20 are pending. Claims 15-20 are examined on the merits.

Election/Restrictions

Applicant's election without traverse of Group II (Claim 15-20), species cappaprenol 12 and palmitic acid, in the reply filed on April 9, 2008 is acknowledged.

Claims 1-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 9, 2008.

Response to Arguments

Applicant's arguments, filed Oct. 13, 2008, with respect to the rejection(s) of claim(s) 15-20 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 15, 17-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Schutz et al. (2004, SOFW, 130, 57-64).

Schutz et al. teaches Capparis spinosa bud extract have palmitic acid, linoleic acid (as fatty acids), and caper bud extracts exhibit strong anti-oxidant and free radical scavenging effect, which has been attributed to the presence of phenolic compounds identified in Capparis spinosa bud extracts (Capers, paragraphs 1-3). Flower buds are rehydrated, grinded and mixed with octyl-dodecyl myristate and extracted using supercritical CO₂ extraction process, where cappaprenols are extracted (High quality and friendly extraction process, paragraphs 1-4). Highly water soluble glucosinates are insoluble in octyl-dodecyl myristate and extracts are free of glucosinates (High quality and friendly extraction process, paragraph 6). Caper bud extract, 2% Gatuline Derma-Sensitive, was applied as a cream on volunteers with sensitive, reactive skin, subject to discomfort and diffuse redness, where the product was applied on one side of the face (In vivo efficacy, paragraph 1). Capparis spinosa bud extraction would inherently contain cappaprenols 12 because the plant source and extraction process are the same.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schutz et al. (2004, SOFW, 130, 57-64).

Schutz et al. teaches *Capparis spinosa* bud extract have palmitic acid, linoleic acid (as fatty acids), and caper bud extracts exhibit strong anti-oxidant and free radical scavenging effect, which has been attributed to the presence of phenolic compounds identified in *Capparis spinosa* bud extracts (Capers, paragraphs 1-3). Flower buds are rehydrated, grinded and mixed with octyl-dodecyl myristate and extracted using supercritical CO₂ extraction process, where cappaprenols are extracted (High quality and friendly extraction process, paragraphs 1-4). Highly water soluble glucosinates are insoluble in octyl-dodecyl myristate and extracts are free of glucosinates (High quality

and friendly extraction process, paragraph 6). Caper bud extract, 2% Gatuline Derma-Sensitive, was applied as a cream on volunteers with sensitive, reactive skin, subject to discomfort and diffuse redness, where the product was applied on one side of the face (In vivo efficacy, paragraph 1). Capparis spinosa bud extraction would inherently contain cappaprenols 12 because the plant source and extraction process are the same. However, it does not teach the 14.8-42 mg in 100 g of a fat.

The reference does not specifically teach adding the ingredients in the amounts claimed by applicant, which is from 0.148-0.42%. However, the reference does teach the composition topical use. Schutz teaches caper bud extract, 2% Gatuline Derma-Sensitive, was applied as a cream on volunteers with sensitive, reactive skin, subject to discomfort and diffuse redness, where the product was applied on one side of the face (In vivo efficacy, paragraph 1). The amount of a specific ingredient in a composition that is used for a particular purpose (the composition itself or that particular ingredient) is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of

unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

Conclusion

No claim is allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catheryne Chen whose telephone number is 571-272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Catheryne Chen
Examiner Art Unit 1655

/Michael V. Meller/

Primary Examiner, Art Unit 1655